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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,522	07/06/2007	Peter Hearn	201501201125-US2	1281
7278	7590	09/28/2009		
DARBY & DARBY P.C. P.O. BOX 770 Church Street Station New York, NY 10008-0770			EXAMINER EGLOFF, PETER RICHARD	
			ART UNIT	PAPER NUMBER
			3715	
			MAIL DATE	DELIVERY MODE
			09/28/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/599,522

**Applicant(s)**

HEARN ET AL.

**Examiner**

PETER R. EGLOFF

**Art Unit**

3715

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date 9/29/06

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date: \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The non-patent references cited in the information disclosure statement dated 29 September 2006 have not been considered because the IDS does not cite a date, or an indication that no date is available, for each reference. In order for a reference to be considered, there must be a date provided for the reference, or an indication that no date is available. See MPEP § 609. The references that were not considered have been indicated with a line through them in the attached annotated copy of the IDS.

### ***Claim Rejections - 35 USC § 101***

2. Claims 1-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order for a claimed process to be considered statutory it must be: (1) tied to a particular machine or apparatus, or (2) transform a particular article into a different state or thing. The use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility; the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity; and any transformation must be central to the purpose of the claimed process. In the instant case, independent claims 1 and 13 recite the steps of transmitting questions, receiving answers, responding to the answers, and determining a product (as per claim 1), and transmitting questions, receiving answers, responding to the answers, determining correct or wrong, and sending a notification (as per claim 13), but do not set forth a particular apparatus (such as a computer) that is utilized to perform the steps. The recitation of a network in the preamble of the

claims is noted, however the claims do not set forth particular components of the network and how these components are utilized to perform the recited steps. The claims further fail to transform a particular article into a different state or thing. Claims 2-12, 14 and 15 inherit the deficiencies of their respective parent claims and are thus rejected for the same reasons.

*Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Ishida (US Patent No. 6,514,080 B2).

Regarding claim 13, Ishida discloses a method for training a student in a skill partially over a network comprising the steps of: transmitting, to the student, at least one of a first set of questions based on the skill; receiving from the student an answer to at least one of the first set of questions; and responding to the answer to the first set of questions in real time, comprising the steps of: determining if the answer is one of a correct answer and a wrong answer; sending, if the correct answer, a correct notification to the student, wherein the correct notification includes the correct answer; and sending, if the wrong answer, a incorrect notification to the student, wherein the incorrect notification includes the wrong answer and the correct answer (column 4, line 41 – column 5, line 2).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1, 4-6 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida (US Patent No. 6,514,080 B2).

Regarding claims 1, 4-6 and 9-12, Ishida discloses a method for training a student in a skill partially over a network comprising the steps of: transmitting, to the student, at least one of a first set of questions based on the skill; receiving from the student an answer to at least one of the first set of questions; and responding to the answer to the first set of questions (column 4, lines 41-61); determining a product (scuba training) related to the at least one of the first set of question; and including in the response an advertisement for the product (column 6, lines 1-18) (as per claim 1), training the student in a physical aspect of the skill at a training location (column 5, lines 6-23) (as per claim 4), selling training materials to the student at a training

location (column 6, lines 1-18) (as per claim 5), the first set of questions is based on the training materials (column 4, lines 41-61) (as per claim 6), the responding step comprises the steps of: determining if the answer is one of a correct answer and a wrong answer; sending, if the correct answer, a correct notification to the student, wherein the correct notification includes the correct answer; and sending, if the wrong answer, a incorrect notification to the student, wherein the incorrect notification includes the wrong answer and the correct answer (as per claim 9), and the determining step is performed by a representative of the product (as per claim 10), the determining step is performed by the preferred training location (as per claim 11), the responding step comprises the step of providing at a value of the at least one first question (as per claim 12) (column 4, line 41 – column 5, line 2). It is noted that Ishida does not explicitly disclose responding to the student's answers is performed in real time (as per claim 1). However, the examiner takes OFFICIAL NOTICE that the concept and advantages of providing real-time feedback to answers given by students in online testing is old and well known. Therefore, it would have been obvious to modify the teachings of Ishida by providing the responses in real time, with the motivation of allowing the student to receive instant feedback regarding his answers.

8. Claims 2, 3, 7, 8, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida (US Patent No. 6,514,080 B2) in view of Kouba et al. (US Patent No. 6,325,631 B1).

Regarding claims 2, 3, 7, 8, 14 and 15, Ishida further discloses providing further training at a training location (column 5, lines 3-10), but does not explicitly disclose displaying, to the student, a list of at least one training locations; and receiving, from the student, a preferred

training location selected from the list of training locations (as per claims 2 and 14), querying the student, at a training location, with at least one of a second set of questions based on the skill (as per claims 3 and 15), the second set of questions is based on training materials (as per claim 7), and the training materials are at least one of text books, video tapes, audio tapes, flashcards, CD-Rom, DVD, and computer software (as per claim 8).

However, Kouba discloses a skill testing system where student are provided a list of testing locations and choose a preferred location (see Fig. 2). Furthermore, the examiner takes OFFICIAL NOTICE that the concepts of advantages of providing training materials in the form of book, tapes, or software are old and well known. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the teachings of Ishida by allowing the user to choose a testing location, providing further question and answer sets at the location, and providing further training materials in the form of books, tapes, or software, with the motivation of providing the student further training at the student's convenience.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lydon et al. (US Patent No. 6,984,177 B2) discloses a method of communicating programmer information to potential employers. Summers (US 2005/0004789 A1) discloses a management training simulation method and system.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Egloff whose telephone number is (571) 270-3548. The examiner can normally be reached on M-F 7:30am - 5:00 pm EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached at (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kathleen Mosser/  
Primary Examiner, Art Unit 3715

Peter Egloff